



Attorney Docket: 037116.44159CP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Paul BRAZEAU et al.

Patent No.: 6,020,311

Issued: February 1, 2000

Title: GRF ANALOGS WITH INCREASED BIOLOGICAL POTENCY

PETITION TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.324

Mail Stop Petitions

Commissioner for Patents

Alexandria, VA 22313-1450

Sir:

The Commissioner is hereby respectfully petitioned to correct the inventorship of the above-identified patent by adding Abdelkrim Habi as a co-inventor, and to issue a certificate naming the actual inventors.

Accompanying this Petition are:

1. A statement from the person being added as an inventor that the inventorship error occurred without any deceptive intention on his part.
2. A statement from the current named inventors agreeing to the change of inventorship.
3. A statement from the Assignee of the entire interest in the patent agreeing to the change of inventorship and complying with 37 C.F.R. §3.73(b).
4. A check in the amount of \$130.00 in payment of the fee under 37 C.F.R. §1.20(b). This amount is believed to be correct, however the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to deposit account no. 05-1323 (Docket #037116.44159CP).

If there are any questions regarding this Petition, a telephone call to the undersigned at (202) 624-2845 would be appreciated.

Respectfully submitted,

October 21, 2003



J. D. Evans, Registration No. 26,269

CROWELL & MORING, LLP
P.O. Box 14300
Washington, DC 20044-4300



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 10

In re Patent No. BRAZEAU ET AL.

Issue Date: 02/01/00

Appl No.: 09/148,982

Filed: September 08, 1998

For: Abdelkrim Habi

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: **DECISION GRANTING**
: **PETITION**
: **37 CFR 1.324**
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This is a decision on the petition filed 10/21/03 to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

Brenda Brumback

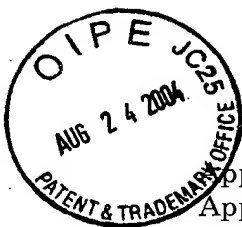
Brenda Brumback

Supervisory Patent Examiner

Art Unit 1654

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IFW 1654/16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/786,639 Confirmation No. : 3737
Applicant : Denis GRAVEL, et al.
Filed : June 27, 2001
TC/A.U. : 1654
Examiner : Michael Meller
Docket No. : 037116.49753
Customer No. : 23911
Title : Grf Analogs with Increased Biological Potency

REPLY TO OFFICE ACTION

Mail Stop **Amendment**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply is accompanied by a Petition under 37 CFR 1.136(a) for a three month extension of time, and by a check in the amount of \$950.00 in payment of the required extension of time fee.

This is a Reply to the Office Action mailed February 24, 2004 in the above-identified patent application.

Reconsideration of the application is respectfully requested in view of the following remarks.

The rejection of claims 1 and 2 under 35 U.S.C. §102(e) over Brazeau et al., U.S. Patent No. 6,020,311 or Brazeau et al., U.S. Patent No. 6,194,384 is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

As noted in the Office Action, 35 U.S.C. §102(e) provides in pertinent part:

A person shall be entitled to a patent unless –
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent

The '311 patent does not satisfy the requirements of §102(e) because it is not "by another". Attention is directed to the fact that the inventorship of the

'311 patent has been amended to add Abdelkrim Habi as a co-inventor. As evidence hereof, attached are copies of the Petition to Correct Inventorship under 37 C.F.R. 1.324, filed October 21, 2003, and a copy of the Decision Granting Petition, mailed May 17, 2004, in said patent. Accordingly, the inventors of the '311 patent and the inventors of the present application are the same, and the rejection cannot stand.

Indeed, for the sake of completeness of the record, Applicants wish to point out that their PCT application, PCT/CA99/00816, of which the present application is the U.S. national stage, claims priority from U.S. patent application serial no. 09/148,982, from which the '311 patent issued.

As for U.S. Patent no. 6,194,384, the named inventors of that patent are also inventors of the present application. Although the '384 patent apparently discloses some compounds within the scope of the presently claimed invention, it is logically impossible for the inventors to have disclosed these compounds in the application which matured into the '384 patent before the compounds were invented. The compounds must have been invented before the '384 patent application was filed. It follows that the '384 patent cannot satisfy the requirement of §102(e) that the application be filed 'before the invention thereof by the applicant for patent." Reconsideration and withdrawal of the rejection are therefore respectfully requested.

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt, favorable action thereon is earnestly solicited.


If there are any questions regarding this response or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

Application No. 09/786,639
Reply to Office Action
August 24, 2004

please charge any deficiency in fees or credit any overpayments to Deposit
Account No. 05-1323 (Docket # 037116.49753).

Respectfully submitted,



J.D. Evans
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August 24, 2004
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